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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,938	06/21/2002	James H. Eberwine	PENN-0794	5996
26259 7590 10/17/2003				
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053				
EXAMINER				
SOUAYA, JEHANNE E				
ART UNIT		PAPER NUMBER		
1634				

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

10/018,938

## Applicant(s)

EBERWINE ET AL.

## Examiner

Jehanne E Souaya

## Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 21 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_. 5) ☐ Notice of Informal Patent Application (PTO-152) 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I-XIII, claim(s) 1, in part, drawn to a nucleic acid encoding in the alternative, 13 different proteins. For example, if group I is elected, claim 1 will be examined to the extent that it applies to y-adaptin. If group XIII is elected, claim 1 will be examined to the extent that it applies to a7 subunit.

Group XIV, claim(s) 2, drawn to a method of diagnosing schizophrenia in a patient by comparing in a cell or tissue, relative levels of mRNAs for genes and ESTs differentially regulated in patients with schizophrenia as compared to mRNA levels of genes unaltered in schizophrenic patients.

Group XV, claim(s) 3, drawn to a method of evaluating agents for treatment of schizophrenia by comparing levels of mRNAs for genes and ESTs before and after the agent is administered.

2. The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the nucleic acid encoding each of the structurally and functionally distinct polypeptides, are themselves structurally and functionally distinct and do not share the same or corresponding special technical feature. Further, unity of invention is not present as sequences encoding GluR1, for example, were known in the art at the time of the invention (see Sokolov, B.P.; Journal of Neurochemistry, 1999, vol. 71, pp 2454-2465).

3. Groups I-XIII are patentably distinct because each protein is directed to a structurally and functionally distinct polypeptide. Accordingly, nucleic acids encoding such are structurally and functionally distinct.

The products of groups I-XIII are patentably distinct from the methods of groups XIV and XV because the methods of diagnosing schizophrenia and evaluating agents for treatment of schizophrenia do not require use of any of the products of groups I-XIII.

The method of group XIV is patentably distinct from the method of group XV because the methods require different process steps and are unobvious over one another.

4. A telephone call was made to Jane Massey Licata on October 14, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703) 308-6565. The examiner can normally be reached Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Jehanne Souaya*

Jehanne Souaya  
Primary Examiner  
Art Unit 1634

*10/17/03*